

III. REMARKS

1. Claims 17 and 18 are amended. Claims 19-24 are new.
2. Claims 1-16 are not unpatentable under 35 U.S.C. §103 over Jones, US 6,606,506 in view of Arazi, US 6,430,395. Claim 1 recites a mobile station and a headset separate from the mobile station. Each of the mobile station and headset in claim 1 comprise a short range transceiver for wireless communication. The headset has a memory for storing files and a media player arranged to decode stored files. The combination of Jones and Arazi does not disclose or suggest at least that the headset has a media player arranged to decode files that are stored in the headset.

The Examiner states on page 3 of the Office Action that Jones discloses a media player in the headset as claimed by Applicant. It is respectfully submitted that there is no such disclosure. Figure 6 of Jones is described at column 6, lines 14-45. In Jones the remote control display unit 72 includes CD controls 74, radio controls 76, a transmitter 78 and a time/clock display panel 80 (column 6, lines 15-17). The master control unit 18 includes the processing means 84, the receiver 82, the phone controls 88, the pager 92, which includes the pager controls and a tape player 90, which includes a tape player control (column 6, lines 24-27). The remote unit 72 includes the CD controls 74, the radio controls 76, the transmitter 78 and the time/clock display 80 (column 6, lines 31-33). The processing means 84 in Jones is configured so as to play a soft beep through the speakers 16 to alert the user that a page or a call has been received (column 6, lines 39-42). Nowhere is there any disclosure or suggestion in Jones that there is a decoder or decoding function in the headset 12 with respect to Figure 6. While a decoder 68 is mentioned at column 6, lines 46-60 referring to Figure 4, this decoder 68 does not reside in the headset 12 as claimed by Applicant.

The headset 12 is shown in Figure 1 of Jones. The headset 12 includes a first speaker housing 14A and a second speaker housing 14B, each having a speaker 16. A digital music source 17 is coupled to one of the speaker housings. (Column 3, L. 15-20).

Nowhere does Jones disclose or suggest that the headset 12 has a media player arranged to decode files that are stored in the headset.

In Jones, the micro control mp3 block 68, which “decompresses”, i.e., decodes, the music resides in the control unit 18 as can be seen in Figure 4 (See column 2, lines 65-67, which specifically recites that “Fig. 4 is a block diagram of the control/display unit portion of the personal entertainment and communication device”). The micro control mp3 block 68 is not shown or described with reference to any other figure. In particular the micro control mp3 block 68 is not described with respect to Figure 1, which illustrates the headset.

The place where digital music is stored does not determine where the music is decoded. Although the headset in Jones has a slot for a 32-Megabyte module that has encoded mp3 music, this does not mean that the music files are decoded in the headset. It is certain that in Jones the mp3 decoder block 68 resides in the control/display unit 18 (See the description at column 5, lines 52-65; column 6, lines 46-60; and Figure 4). The decoding occurs in the control/display unit 18 of Jones, not in the headset 12.

Combining Jones with Arazi fails to remedy the above noted defect. Arazi is directed to the problem of seamlessly connecting mobile units to various devices and networks without using various expensive devices or software (see column 3, lines 45-55) and is only cited by the Examiner as disclosing Bluetooth communications.

Thus, the combination of Jones and Arazi does not disclose or suggest a headset having a media player arranged to decode files that are stored in the headset as recited in Applicant's claim 1. Therefore claim 1 is patentable. Claim 13 is patentable over the combination of Jones and Arazi for reasons that are substantially similar to those described above with respect to claim 1. Claims 2-12 and 14-16 are patentable at least by reason of their respective dependencies.

Moreover, it is respectfully submitted that there is no legal motivation to combine Jones with Arazi. In order to establish a *prima facie* case of obviousness under 35 U.S.C.

103(a), there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. § 2142). As noted above, the combination of Jones and Arazi does not disclose or suggest each feature of Applicant's claims. Thus, a *prima facie* case of obviousness cannot be established.

Neither Jones nor Arazi provide any suggestion or motivation to be combined or modified as proposed by the Examiner and the Examiner's proposition that Applicant's invention would be obvious as recited in the claims is not supported by the factual contents of Jones or Arazi.

As described above, in Jones, the micro control mp3 block 68 resides in the control unit 18 as can be seen in Figure 4 (See column 2, lines 65-67, which specifically recites that "Fig. 4 is a block diagram of the control/display unit portion of the personal entertainment and communication device"). Nowhere does Jones disclose or suggest that the micro control mp3 block is located in the headset 12.

Arazi merely discloses methods to create a cellular-like communications system, such as a Wireless Private Branch Exchange, that includes mobile devices utilizing the Bluetooth short-range wireless communication protocol and nothing more.

Because neither Jones nor Arazi disclose or suggest all the features of Applicant's claims one skilled in the art would not be motivated to combine Jones with Arazi to arrive at what is claimed by Applicant without the use of hindsight reasoning.

Even if Jones and Arazi were combined the result would be the personal entertainment and communication device of Jones (with the mp3 decoder 68 in the control/display unit 18) having the capability of connecting to the cellular-like communication system of Arazi and nothing more. This is not what is claimed by Applicant. Again, Applicant's

claims call for a headset having a media player arranged to decode files that are stored in the headset.

When “the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference”. In re Rijckaert, 28 USPQ2d 1955, 1057 (Fed. Cir. 1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the reference. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Jones and Arazi under 35 U.S.C. 103(a) is not established.

Further, it is respectfully submitted that Jones and Arazi have been combined improperly. References may be combined under 35 U.S.C. 103(a) only if the references are analogous art. In this case Arazi is not analogous art. A reference is analogous art if:

- 1) The reference is in the same field of endeavor as the applicant’s, or
- 2) The reference is reasonably pertinent to the particular problem with which the applicant was concerned.

Arazi is not in the same field of endeavor as recited in Applicant’s claims. Arazi is directed to methods create a cellular-like communications system, such as a Wireless Private Branch Exchange, that includes mobile devices utilizing the Bluetooth short-range wireless communication protocol and nothing more. This is not the same as what is claimed by Applicant. Applicant’s claims are directed to a headset for hands-free implementation of the call where the headset comprises a memory for storing the files and a media player arranged to decode the stored files.

In addition, Arazi is not reasonably pertinent to the particular problem with which Applicant was concerned, namely a headset for hands free operation of a mobile station as described above. The cellular like communication network of Arazi has nothing to do

with a headset for hands free operation of a mobile station as recited in Applicant's claims. Thus, Arazi does not address the problems addressed by Applicant's claims.

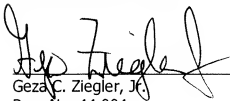
Since, Arazi is not in the same field of endeavor as the Applicant's endeavor and is not reasonably pertinent to the particular problem with which the Applicants were concerned, Arazi is not analogous art. Therefore, Arazi cannot be combined with Jones.

3. Claims 17 and 18 are rewritten to be in an independent form and are now allowable as indicated on page 7 of the instant Office Action.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for one additional independent claim and four additional dependent claims as well as any other fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


Geza C. Ziegler, Jr.
Reg. No. 44,004

27 Feb 2007
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being transmitted electronically, on the date indicated below, addressed to the Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 27 February 2007

Signature: Natalie Ivanoff
Natalie Ivanoff
Person Making Deposit